

## REMARKS

At the time the Office Action issued, claims 1 – 12 were pending. The Office Action rejects all claims.

Examiner is respectfully thanked for the acknowledgements regarding Applicant's prior election and receipt of priority documents.

### Claim objections

Claim 5 has been objected to as being in improper form. The objection has been overcome by amendment, which replaces "any preceding claim" with "claim 1".

New claims 27 to 29 recite subject matter from claim 5, respectively in dependence of claims 2 to 4. No matter has been added.

### Claim rejections under 35 USC § 112

In Numbered paragraphs 5 to 7, claims 1 to 12 have been rejected under 35 USC § 112, second paragraph. The Office Action specifically raises two issues of insufficiency of antecedent basis in claim 1.

In order to overcome the rejections, claim 1 has been amended to provide antecedent basis.

Attorney for Applicant respectfully submits that this also overcomes the rejection of claims 2 to 7 as a result of their ultimate dependency on claim 1.

However, Attorney respectfully fails to see how the rejections have been relevant to claims 8 to 12, none of which is dependent on claim 1.

Reconsideration is respectfully requested.

### Claim rejections under 35 USC § 102

In Numbered paragraphs 8 and 9, claims 1, 4, 6-8, and 10-12 have been rejected under 35 USC § 102(b) as being anticipated by Minarovic (US 4,947,012).

The Office Action asserts that Minarovic discloses a method of marking a location of a tubular joint, the method comprising the steps of:

creating a cavity in the form of an inner wall (20) into an end surface of one of the tubular ends (12) that are to be joined together (figure 1);

inserting a marker (22) into said cavity (figure 1); and

subsequently joining the tubular ends (figs. 4a-4b and abstract).

Attorney for Applicant respectfully traverses the rejections.

The assertion that Minarovic discloses creating a cavity into an end surface of one of the tubular ends, is incorrect. Minarovic does not teach creating a cavity (wherein a marker (22) is inserted) into an end surface.

Minarovic does show a winding of a wire forming coil 22 along an inner wall (20) of fitting 12 (see Col. 3 lines 24-26). But a cavity formed by the inner wall of a fitting is not disclosing or teaching “creating a cavity into an end surface of one of the tubular ends”.

Thus, asserted anticipation of claim 1 and its dependent claims by Minarovic is not supported by the art. Reconsideration and, ultimately, withdrawal of the rejection is therefore respectfully requested.

With regard to claims 8 to 12, it is respectfully submitted that claim 8, at least in its amended form, calls for “a marker arranged in a cavity that has been created into an end surface of at least one of the tubulars”. As explained above, Minarovic fails to disclose or teach a cavity created into an end surface of at least one of the tubulars.

Reconsideration is respectfully requested.

#### Claim rejections under 35 USC § 103

In Numbered paragraphs 10 and 11, claims 2-3 and 9 have been rejected under 35 USC § 103(a) over Minarovic (US 4,947,012) in view of Moe (US 4,736,084).

The Office Action states that tubular ends being joined by welding/forging are well known in the art and can be found in Moe's reference. Moe is stated to teach the use of forging technique to join tubular ends together.

Attorney for Applicant respectfully traverses the rejection.

MPEP 2143 expressly state “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally the prior art references must teach or suggest all the claim limitations."

In the present case, the prior art references do not teach or suggest all the claim limitations.

Claims 2 and 3 incorporate the subject matter of claim 1 and claim 9 incorporates the subject matter of claim 8. Thus, a *prima facie* case of obviousness requires that all the elements of claim 1 and 8 are taught by the prior art references.

It has been shown above that Minarovic does not disclose or teach creating a cavity into an end surface of one of the tubular ends. Moe does not disclose or teach this element, either.

It is therefore respectfully submitted that, at least for that reason, no *prima facie* case of obviousness has been presented by the examiner.

Concluding remarks

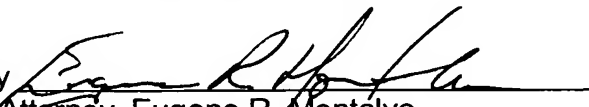
Attorney has addressed each and every ground for objection and rejection raised by the Examiner in the Final Office Action. Attorney respectfully submits that the claims, original, amended, and new, are in a state ready for allowance, and as such prompt issuance of a Notice of Allowance is respectfully requested.

In the event the Examiner has any questions or issues regarding the present application, the Examiner is invited to call the undersigned prior to the issuance of any advisory action.

Respectfully submitted,

Johannis J. Den Boer et al.

By

  
Attorney, Eugene R. Montalvo  
Registration No. 32,790  
(713) 241-0296

P.O. Box 2463  
Houston, Texas 77252-2463